

REMARKS

The Official Action mailed June 4, 2003, has been received and its contents carefully noted. Filed concurrently herewith is a *Request for Two Month Extension of Time*, which extends the shortened statutory period for response to November 4, 2003. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Official Action requests that the Applicant provide copies of all foreign references cited in the Information Disclosure Statement filed on November 26, 2001 (page 2, Paper No. 11). In response, the Applicant submits herewith copies of the foreign references and non-patent literature cited in the IDS filed November 26, 2001. The Applicant respectfully requests that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of this IDS.

Claims 2-9 were pending in the present application prior to the above amendment. New claims 10-12 have been added to recite additional protection to which the Applicant is entitled. Accordingly, claims 2-12 are now pending in the present application, of which claims 2, 4, 7 and 10 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 1 of the Official Action rejects claims 2 and 3 as obvious based on the combination of U.S. Patent No. 4,385,976 to Schuster-Wolden et al. and U.S. Patent No. 4,462,883 to Hart. Paragraph 2 of the Official Action rejects claims 4-9 as obvious based on the combination of Schuster-Wolden, Hart and U.S. Patent No. 4,680,226 to Takeda. The Applicants respectfully traverse the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the

prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Schuster-Wolden and Hart or to combine reference teachings to achieve the claimed invention. Specifically, Schuster-Wolden and Hart do not describe analagous art. The Official Action concedes that "Schuster-Wolden et al. fail to disclose a lead comprising a first layer comprising silver and a second layer comprising indium tin oxide formed on the first layer" (page 3, Paper No. 11). The Official Action relies on Hart to allegedly teach these features. The Official Action asserts that it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify Schuster-Wolden in view of Hart (Id.). However, the Official Action is completely silent as to what motivation there might have existed to modify Schuster-Wolden and Hart. The Applicant respectfully disagrees that it would have been obvious to combine Schuster-Wolden and Hart.

Hart is directed to an entirely different field of endeavor from the present invention and Schuster-Wolden. Specifically, Hart is directed to low emissivity coatings, particularly coatings for window glass (col. 2, lines 5-9 and 51-54), which are entirely irrelevant to a lead to be electrically connected to an IC. Consequently, Hart is not in


the field of the Applicant's endeavor, is not reasonably pertinent to the particular problem with which the inventor is concerned, and would not have logically commended itself to an inventor's attention in considering the problem (see MPEP § 2141.01(a)). Therefore, the Applicant respectfully submits that the Official Action has not provided a proper suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Schuster-Wolden and Hart or to combine reference teachings to achieve the claimed invention.

Takeda does not cure the deficiencies in the motivation to combine Schuster-Wolden and Hart. The Official Action relies on Takeda to allegedly teach the features of an adhesive (page 4, Id.). Takeda does not show that Hart is in the field of the Applicant's endeavor, is reasonably pertinent to the particular problem with which the inventor is concerned, or would have logically commended itself to an inventor's attention in considering the problem.

For the reasons stated above, the Official Action has not formed a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



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